

Remarks

Preliminary Remarks:

Claims 18 to 50 are pending, of which claims 18 and 33 are independent. Claims 22–41, 43–47, and 49–50 previously were withdrawn. The specification currently is amended to delete reference to "the figures". No new matter has been added.

Applicants thank the Examiner for withdrawing the rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103

Claim Rejections:

35 U.S.C. § 101

The Examiner rejects claims 18–21, 42, and 48 under 35 U.S.C. § 101, arguing that the claims lack utility. Applicants respectfully traverse.

The Examiner argues that the present claims lack utility because there allegedly is no support in the specification for the "prophetic statement" that they are useful as herbicides. However, a disclosed utility is presumed to be true and, in the ordinary course, must be taken as definitive of utility. As stated by the M.P.E.P.:

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope.

M.P.E.P. 2107.02(III)(A) (emphasis in original). This presumption cannot be overcome unless the Examiner establishes, *prima facie*, "that it is more likely than not that one of ordinary skill in the art would doubt (i.e., 'question') the truth of the statement of utility." M.P.E.P. 2107.02(III)(A).

The Examiner simply has not set forth any such rationale in this case and thus has not set forth a *prima facie* case of lack of utility. Nonetheless, Applicants have provided the Examiner with two tables demonstrating the herbicidal activity of compounds 1–12, 34, 35, 145, 167, and 168 of Table 1 in the Specification as filed, pages 78–131. As set forth in Tables 1, 2A, and 2B (enclosed herewith), each of these compounds displays both pre- and post-emergent herbicidal activity. Applicants thus submit that the present claims fully satisfy 35 U.S.C. § 101 and respectfully request withdrawal of this basis for rejection.

35 U.S.C. § 112

The Examiner rejects claims 18–21, 42, and 48 under 35 U.S.C. § 112, first paragraph, arguing that the claims are not enabled by the specification. Applicants respectfully traverse.

This rejection is based on the alleged lack of evidence showing herbicidal activity for the claimed compounds. Thus, the Examiner reasons that a person would have to engage in undue experimentation to verify the herbicidal activity of the claimed compounds. As noted above, Applicants have submitted herewith two tables demonstrating the herbicidal activity of several exemplary compounds covered by the claims. The compounds were tested according to the protocol set forth in Use Examples A and B of the specification as filed at pages 158–159. As set forth in Tables 1, 2A, and 2B (enclosed herewith), each of these compounds displays both pre- and post-emergent herbicidal activity when tested according to these methods. Thus, the claimed compounds are fully enabled by the specification. Thus, Applicants respectfully submit that the present claims comply with 35 U.S.C. § 112, first paragraph.

CONCLUSION

In view of the amendments and remarks above, Applicants respectfully submit that this application is in condition for allowance and request favorable action thereon. The Examiner is invited to contact the undersigned if any additional information is required.

Any fees that are required may be charged to Deposit Account No. 50-4254, referencing Attorney Docket No. 2903925-137000.

Customer No.: 84331

RESPECTFULLY SUBMITTED,

BAKER, DONELSON, BEARMAN, CALDWELL &
BERKOWITZ, P.C.

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